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10/574,015	10/19/2006	Hiroimi Akiyoshi	0670-7073	4349
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EXAMINER				
MAWARI, REDHWAN K				
ART UNIT		PAPER NUMBER		
3663				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,015

Applicant(s)

AKIYOSHI ET AL.

Examiner

REDHWAN MAWARI

Art Unit

3663

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-12 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-12 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 09/02/2008.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. This Office Action is responsive to Applicant's amendment and request for reconsideration of application 10/574,015 filed on September 25, 2008.

The amendment contains amended claims: 1-4, 7, 9-12, and 21. Said claims are rejected under the same ground of rejection used in the office action herein.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 10-12, and 21 rejected under 35 U.S.C. 102(b) as being unpatentable over Mannesmann (EP1 106 968 A1).

Consider claim 1, Mannesmann discloses a guide route search device, comprising:

a designation unit adapted to designate at least two or more destinations (abstract, and Figure 4);

a creation unit adapted to create plural route patterns in which orders of visit to the plural destinations are different from one another (abstract, and Figure 4); and

a judgment unit adapted to judge whether the plural route patterns are route patterns that satisfy destination conditions in all the destinations ([paragraph 0016], and Figure 4).

Furthermore, Mannesmann discloses a route pattern edition unit, for route patterns in which destinations are judged as satisfying the destination conditions by the judgment unit, any one of addition of destinations, deletion of destinations, change of destinations, and rearrangement of destinations as correction of the route patterns and causing the judgment unit to judge whether destinations in the route patterns after the correction satisfy the destination conditions ([paragraph 0017]).

Consider claim 2, Mannesmann discloses a selection unit adapted to select a guide pattern that satisfies the destination conditions in all the destinations as a guide route ([paragraph 0003]).

Consider claim 3, Mannesmann discloses an adjustment unit adapted to perform, for route patterns judged as not satisfying the destination conditions at least at one destination by the judgment unit, adjustment of a non-traveling time such that the route patterns satisfy the destination conditions in all the destinations ([paragraph 0017]); and

a selection unit adapted to select a specific route pattern out of the route patterns judged as satisfying the destination conditions in all the destinations by the judgment unit and the route patterns updated by the adjustment unit ([paragraph 0003]).

Consider claim 4, Mannesmann discloses an update unit adapted to update, for route patterns judged as not satisfying the destination conditions at least at one destination by the judgment unit, the route patterns such that the route patterns satisfy the destination conditions in all the destinations ([paragraph 0013]); and

a display unit adapted to display at least two route patterns out of the route patterns judged as satisfying the destination conditions in all the destinations by the judgment unit and the route patterns updated by the updating means ([paragraph 0012]).

Consider claim 10, Mannesmann discloses that the selection unit judges whether route points of identical or similar genres continue in the route pattern and, when destinations of identical or similar genres do not continue, selects the route pattern as the guide route ([paragraph 0003]).

Consider claim 11, Mannesmann discloses wherein the route pattern edition unit has a sub-unit for inserting, in which a new destination is inserted in a certain insertion place in route patterns in which destinations are judged as satisfying the destination conditions by the judgment unit, when it is judged by

the judgment unit that destinations in the route patterns after correction do not satisfy the destination conditions, the new destination in another insertion place on the guide route ([paragraph 0003]).

Consider claim 12, Mannesmann discloses characterized in that, the guide route search device has a sub-unit for inserting, in response to the addition of a destination by the route pattern edition unit, a new destination in each of plural insertion places, in which a destination can be inserted, on, route patterns in which destinations are judged as satisfying the destination conditions by the judgment unit to create plural route patterns, by a creation unit contained in the hardware processor; and causes the judgment unit to judge whether destinations satisfy the destination conditions for each of the plural route patterns created, by a judgment unit contained in the hardware processor ([paragraph 0017]).

Consider claim 21, claim 21, is rejected using the same art and rationale used to reject claim 1.

Note: Above claims use statement of intended use or field of use, "adapted to", "wherein" are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mannesmann (EP) in view of Katayama et al. (2001/0029429).

Consider claim 7, Mannesmann discloses a display unit adapted to display the guide route selected by the selecting means on a map image together with an image indicating a location of the guide route search device itself before route guide ([paragraph 0012]); however Mannesmann doesn't explicitly disclose a movement unit adapted to move the image indicating a location of the guide route search device itself along the guide route;

Katayama teaches a movement unit adapted to move the image indicating a location of the guide route search device itself along the guide route (abstract);

a time calculation unit adapted to calculate an arrival time at a location of the image moved by the moving means (FIG. 4); and

an update unit adapted to change a color and/or brightness of the map image according to the arrival time calculated ([paragraph 0013]).

Accordingly, it would have been obvious to an ordinary skilled person in the art to combine the invention of Katayama into the invention of Mannesmann for the purpose of simplify the display for the user.

Consider claim 9, Mannesmann discloses wherein the judgment unit includes a destination condition update unit adapted to update, when the destination for each genre is not in a business hour of the destination, updating the destination conditions for each genre such that the destination conditions for each genre are in a business hour of the route point ([paragraph 0013]).

Note: Above claims use statement of intended use or field of use, "adapted to", "wherein" are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference.

Response to Arguments

6. Applicant's arguments have been fully considered but are not persuasive. In particular the applicant argues, A) **Official Action, rather than setting forth statements which clearly set forth how the prior art reference teaches all the features of previously pending claim 6, either explicitly or inherently, the Official Action instead merely reproduces Applicant's claim 6 and adds a parenthetical notation, i.e. "paragraph 0017," without further comment or explanation (page 6,**

Paper No. 20080617). However, the Applicant respectfully submits that the Official Action fails to set forth how Mannesmann necessarily teaches at least the above-referenced features of claims 1 and 21, either explicitly or inherently. Further, the Applicant respectfully submits that Mannesmann does not, in fact, teach at least the above-referenced features".

B) applicant appears to be arguing that there is no reason or suggestion to combine prior art of record.

In response to A) examiner respectively disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Given the broadest interpretation, as claimed it is the examiner's position, the reference of record teaches what he is argued (***a route pattern edition unit, for route patterns in which destinations are judged as satisfying the destination conditions by the judgment unit, any one of addition of destinations, deletion of destinations, change of destinations, and rearrangement of destinations as correction of the route patterns and causing the judgment Unit to judge whether destinations in the route patterns after the correction satisfy the destination conditions***). As noted in paragraph [0017], it is clear to the examiner that this passage supports "***any one of addition ..., deletion of destination, etc..."***" "Any one of" means at least one of". According to paragraph 0017, at least one of the conditions as cited " for example deleting destinations, changing destinations etc...".

In response to B) applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been extremely advantageous to combine the prior art of record for the purposes stated in the detailed action below. In addition, KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d ,slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, USPQ2d at 1396) (available at <https://www.uspto.gov/web/offices/dcom/bpai/prec/fd071923.pdf>). Therefore the combination of the prior art of record still meets the scope of the limitations as currently claimed. Furthermore, *Note: Above claims use statement of intended use or field of use, "adapted to", "wherein" essentially method limitations or statements are or intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference.*

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Redhwan Mawari whose telephone number is 571 270 1535. The examiner can normally be reached on 7:30 AM - 5PM Mon-Fri Eastern Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/22/2008

/R. M./

Examiner, Art Unit 3663

/Tuan C To/
for Mawari, Redhwan, Examiner of Art Unit 3663/3600